

FROM :

FAX NO. :203-397-5164

Oct. 28 2003 03:00PM P1

Fax to: 703-308-4242
Attn.: Nirmal S. Basi
Art Unit: 1646
Tel.: 703-308-9435

From: John A. Peyman
Tel./Fax: 203-397-5164
Date: 28 October 2003
Time: 2:00 pm

Re: Application No. 09/876,478
Response to non-final office action

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Fax transmitted 28-OCT-03, Appl. 09/876,478

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: JOHN A. PEYMAN
Application Number: 09/876,478
Filed: 07 June 2001
For: Interferon-Suppressing Placental Lactogen Peptides
Art Unit: 1646
Authorized Officer: Nirmal S. Basi

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FACSIMILE LETTER TRANSMITTING
ELECTION OF CLAIMS WITH TRAVERSE PURSUANT TO 35 U.S.C. 121

Sir:

In response to the Office Action dated 3-OCT-2003, in connection with the above-named application and in accordance with the requirements of 35 U.S.C. 121, please consider the election of claims and the remarks below.

ELECTION OF CLAIMS

Applicant chooses the provisional election of Invention I, consisting of Claims 1, 3, 4, 5 and 9, while respectfully requesting reconsideration and modification by the Authorized Officer of the requirement for restriction. The remarks below provide the reasoning for this request.

REMARKS

The Applicant agrees with the Authorized Officer that the application contains independent and distinct inventions of composition, namely, those of Inventions I and II.

In addition, the Applicant agrees that Invention I and the methods of Inventions III and V are related as product and process of use, as are Invention II and the methods of Inventions IV and VI. However, the Applicant respectfully disagrees that the product as claimed can be used in a materially different process. The peptide of claim 1 of Invention I, for example, was discovered by its functional properties as an Interferon-Suppressing Placental Lactogen Peptide. The specification makes abundantly clear

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these functional properties. Other materially different processes could be applied to peptides in general, but the specific properties of the Interferon-Suppressing Placental Lactogen Peptide of claim 1 are linked in a one-to-one correspondence between the product of Invention I and the specific utilities of each of Invention III and Invention V.

Examples of other materially different processes for peptides in general could include the use of peptides in bulk in animal feed, the use of peptides as chemical intermediates for the preparation of amino acids, the production of antibodies that recognize the peptides, and other processes. Each of these aforementioned processes can be used in general with any peptide, but the suppression of interferon action is not an aspect of these processes. On the other hand, the products of Invention I and the processes of Invention III and V are linked by the functional properties of the peptides of Invention I as claimed, namely, an Interferon-Suppressing Placental Lactogen Peptide.

For these reasons, the Applicant respectfully requests modification of the requirement for restriction, requests redefinition of the group named by the Authorized Officer as Invention I, Invention III, and Invention V, and requests placement of this redefined group into a modified Invention I. Similarly, the Applicant requests modification of Invention II, Invention IV, and Invention VI such that these would form a modified Invention II.

The Applicant further suggests that the proposed modification of the requirement for restriction, that would form modified Invention I and modified Invention II, constitutes a proper separation of the inventions.

Applicant respectfully disagrees with the Authorized Officer and submits that search and examination of the entire application can be made without serious burden. The Applicant points out that the prior art is relatively limited in scope in the field of peptid

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fragments of members of the placental lactogen peptide hormone family and is relatively limited in scope in the field of peptides that suppress interferon action.

CONCLUSION

For the foregoing reasons, the Applicant respectfully requests that the Authorized Officer decide to examine the application on its merits, even though it includes claims to independent or distinct inventions, since there is a one-to-one correspondence between the inventions of modified Invention I, and since the prior art corresponding to modified Invention I is relatively limited in scope.

Respectfully submitted,



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